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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,014

07/25/2003

John Bruce Clayfield Davies

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04/17/2008

WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

EXAMINER

HOFFMAN, MARY C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

04/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/628,014	Applicant(s) DAVIES, JOHN BRUCE CLAYFIELD	
	Examiner MARY HOFFMAN	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 15-19 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Naybour (U.S. Patent No. 6,200,349).

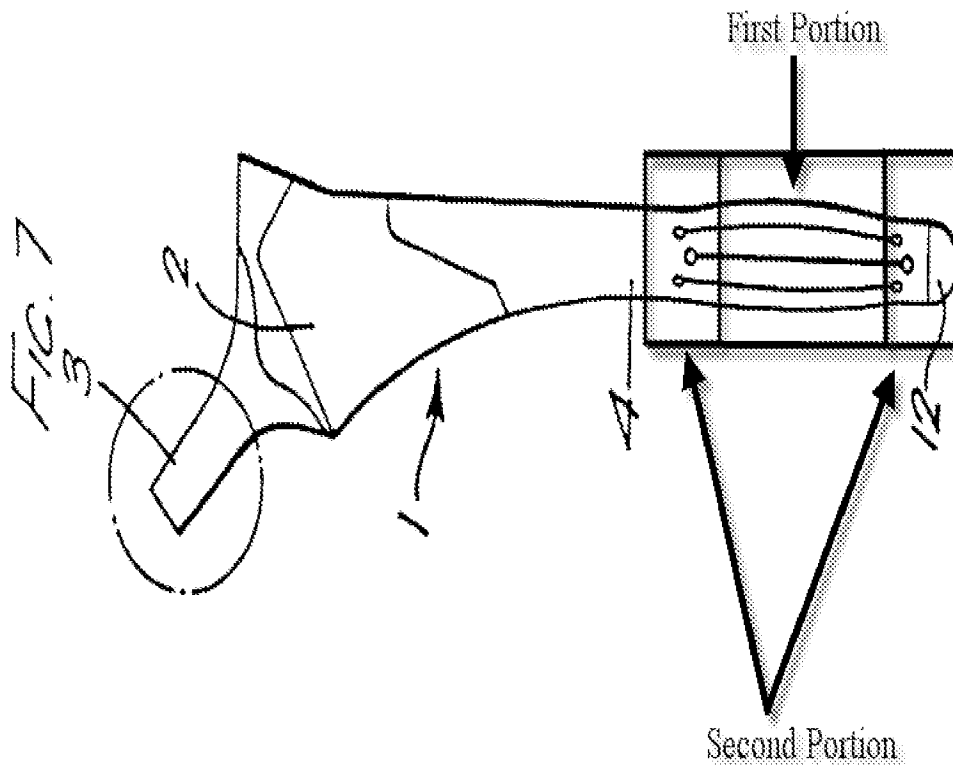
Naybour discloses a bone portion securing device adapted to be received within a bone cavity, the device including at least one expansion portion (ref. #4) capable of being radially expanded under an applied force, the at least one expansion portion having at least one portion (mid-portion of ref. #4, see marked-up figure below), at least one characteristic of which is selected to be different to a corresponding at least one characteristic of at least one other portion (portions surrounding mid-portion, see marked-up figure below) of the expansion portion.

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The at least one characteristic comprises a thickness and/or width of the at least one portion and the at least one other portion. The expansion portion comprises at least one elongate portion having a pair of elongate slots (ref. #6) on either side thereof. The at least one portion comprises a first end of the at least one elongate portion and a second end of at least one elongate portion. The at least one other portion comprises a mid portion of the elongate portion forming a remainder of the elongate portion. The first end and/or second end of the elongate portion is thinner or thicker and/or narrower or broader than an adjacent portion of the at least one elongate portion (see ref. #12). The at least one portion further comprises a first end of at least one slot and a second end of

at least one slot. The at least one other portion comprises a mid portion of the slot forming a remainder of the slot. The first end and/or the second end of at least one slot is broader than an adjacent portion of the at least one slot (see ref. #11). The device including at least one portion capable of being radially expanded under an applied force, wherein the at least one expansion portion is shaped to elastically bow outwards when a compressive force is applied axially to the expansion portion. The device including at least one portion capable of being radially expanded under an applied force, wherein the at least one expansion portion comprises at least one longitudinal portion fixed at either end to means which engage a compression coupling, wherein a profile of the at least one longitudinal portion is narrowed at one or both ends of the at least one longitudinal portion. A plurality of longitudinal portions substantially equidistant spaced around a circumference of the expansion module are provided. The longitudinal portion has a curved profile. The device including at least one portion capable of being radially expanded under an applied force, wherein the at least one expansion portion includes at least one slot, the slot having at least one portion having a width greater than a width of a remainder of the at least one slot. At least one portion and the remainder of the slot are longitudinally displaced. The expansion portion includes a plurality of elongate slots. Each slot includes first and second wider portions at first and second ends of the slot. The remainder of the slot is substantially of a uniform width. The expansion module is made of titanium or titanium alloy (see claim 13 of Naybour). An expansion module for use as a portion of a bone portion securing device adapted to be received within a bone cavity, the module including at least one portion capable of being radially expanded

under an applied force, the at least one expansion portion having at least one portion, at least one characteristic of which is selected to be different to a corresponding at least one characteristic of at least one other portion of the expansion portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naybour (U.S. Patent No. 6,200,349) in view of Gianezio et al. (U.S. Patent No. 4,520,511).

Naybour discloses the claimed invention except for serrations.

Gianezio et al. disclose serrations to increase gripping effect (col. 2, lines 10-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Naybour with serrations in view of Gianezio to increase gripping effect.

Response to Arguments

Applicant's arguments filed 01/18/2008 have been fully considered but they are not persuasive.

Applicant argues that the amended claims overcome the rejection under Naybour and Naybour in view of Gianezio et al. The examiner respectfully disagrees.

With regard to the statements of intended use and other functional statements, i.e. capable of being radially expanded under compressive force applied by a nose portion and an opposing portion couples via a tie rod, they do not impose any structural limitations on the claims distinguishable over Naybour and Naybour in view of Gianezio et al., which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicant's arguments, the recitation “bone nail” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, regarding claim 13, the device of Naybour clearly has a curved profile, as seen in FIGS. 2a-4.

The rejections are deemed proper.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/

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Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733